

Serial No.: 09/876,884

**REMARKS**

Claims 1-14 are pending in the present application. Claims 1-3 and 7-12, the Specification, and the Abstract are amended by this amendment. No new matter is introduced by this amendments, which find support throughout the Specification and Figures. In view of the amendments and the following remarks, reconsideration and allowance of the present application are respectfully requested.

The Examiner objects to informalities in the Specification and the Abstract. The Specification and Abstract have been reviewed and are amended herein to resolve grammatical errors, remove ambiguity, and/or to clarify the subject matter discussed therein. It is therefore respectfully requested that the objections to the Specification and Abstract be withdrawn.

Claims 11 and 12 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 11 and 12 have been amended to clarify that the claims are directed to a computer program. Therefore, it is respectfully requested that the rejection of the claims be withdrawn.

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,594,640 to Postrel et al. (hereinafter Postrel) in view of U.S. Patent 6,078,891 to Riordan (hereinafter Riordan). Applicants respectfully traverse.

The claims are amended herein to amend several of the uses of the term "for" to the phrase "adapted to", or "to". It is respectfully submitted that as formulated, these descriptions properly modify the means described, and should therefore be afforded patentable weight.

Claim 1 relates to an order receiving apparatus that receives an order of commodity transaction from a commodity ordering apparatus through a network. The order receiving apparatus of claim 1 includes, *inter alia*, ***a second storage means adapted to store information specifying combinations of two or more different commodities, and adapted to store specific***

Serial No.: 09/876,884

*parameters concerning economic return, which are applied respectively to said combinations, relating said information and said specific parameters, respectively. The apparatus of claim 1, includes means adapted to perform a step of, inter alia, referring to the second and third storage means, to output information on said combinations of commodities and said specific parameters applied respectively to said combinations, and information on said general-purpose parameter, to said commodity ordering apparatus.*

The Examiner asserts that Postrel discloses all of the features of the independent claims, except the bundling of commodities into combinations. However, the Examiner provides no specific citations to Postrel indicating where the features recited in the claims are disclosed. Applicants respectfully request that the Examiner provide citations to Postrel showing the features of the claims, or alternatively, that the rejections be withdrawn. In particular, Applicants respectfully submit that none of the cited references disclose or suggest a second storage means adapted to store information specifying combinations of two or more different commodities, and adapted to store specific parameters concerning economic return, which are applied respectively to said combinations, relating said information and said specific parameters. Additionally, Applicants respectfully submit that none of the cited references disclose or suggest outputting information on said combinations of commodities and said specific parameters applied respectively to said combinations. Therefore, it is respectfully submitted that the claims are allowable.

Additionally, the Examiner admits the Postrel does not disclose the bundling of items. The Examiner asserts that Riordan discloses this feature, and asserts that "it is commonly known to bundle offers" (Office Action; page 4, lines 5-7). However, the Office Action asserts that the motivation to combine the references is to "create unique offers that would attract shoppers" (Office Action; page 4, lines 11-12). However, this conclusory reasoning is insufficient to

Serial No.: 09/876,884

support a claim of obviousness. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kozab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Federal Circuit addressed the standard for obviousness and the requirement of motivation in Teleflex, Inc. et al. v. KSR Int'l Co., (119 Fed. Appx. 282; 2005 U.S. App. LEXIS 176). The patent at issue in *Teleflex*, related to an electronic pedal position control and a pedal assembly. In *Teleflex*, the district court granted a motion for summary judgment based on invalidity due to obviousness. The Federal Circuit vacated the decision and remanded to the lower court for further proceedings on the issue of obviousness. The Federal Circuit stated that, in regard to obviousness, "a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, *but some motivation to combine the prior art teachings in the particular manner claimed.*" (*Teleflex*, citing *In re Kozab*; emphasis added). The Federal Circuit found that there was no motivation to combine the Asano patent, which disclosed all of the limitations except the electronic control, and the Rixon patent, which disclosed an electronic control and an adjustable pedal assembly. As the court further stated:

[t]he district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, the *test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to*

Serial No.: 09/876,884

*combine the prior art teachings in the particular manner claimed.*

(*Teleflex*, citing as background *Rouffet*, 149 F.3d at 1357; emphasis added).

It is respectfully submitted that the present rejection is similar to the rejection discussed in *Teleflex* in that there is no motivation provided in Postrel to combine its teaching with Riordan. As the *Teleflex* court held, there must be *specific teaching* to motivate a person of ordinary skill in the art must to combine the prior art teachings *in the particular manner claimed*. Therefore, since there is no motivation to combine the referenoes, the rejection is improper.

Claims 2-6 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Additionally, claim 2 further includes a point generating means that performs steps including, *inter alia*, calculating first points when it is judged that the commodities related to the combination are included, said first points being decided based on a specific parameter applied to said combination, or based on the specific parameter applied to said combination and on selling prices of the commodities related to said combination. The Examiner asserts that Riordan's disclosure relating to combinations of commodities discloses this feature. However, Riordan does not appear to disclose or suggest calculating first points for combinations of items and second points for other commodities. Applicants respectfully request that the Examiner provide citations to Postrel or Riordan (the appropriateness of the combination of which is respectfully not conceded) showing the features of the claims, or alternatively, that the rejections be withdrawn. Therefore, for at least this additional reason, claim 2 is allowable.

Serial No.: 09/876,884

Independent claims 7, 9-12, and 14 include features similar to those discussed above in regard to claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

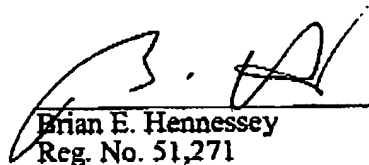
Claim 8 depends from claim 7 and claim 11 depends from claims 11 and 12, and therefore these claims are allowable for at least the same reasons as their respective base claims are allowable.

### CONCLUSION

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

  
Brian E. Hennessey  
Reg. No. 51,271

CUSTOMER NUMBER 026304  
Telephone: (212) 940-6331  
Fax: (212) 940-8986 or 8987  
Docket: 100809-16268 (SCET 18.735)  
BEH:pm